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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,315	11/30/1999	DALE F. MCINTYRE	79909F-P	8863

7590 03/18/2005

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EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/451,315	Applicant(s) MCINTYRE ET AL.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-3 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-33 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Prosecution on the merits of this application is reopened on claims 1-33 considered unpatentable for the reasons indicated below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 19 and 20, there is no antecedent basis for said contest entry number.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 7, 8, 10, 11, 13-17, 22, 23, 25, 26, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsubaki et al (US5815138) in view of Small (US5791991).

Regarding claims 1, 7, 8, 11, 16, Tsubaki et al discloses the idea of a personal computer or interactive TV system that reads/interacts with an interactive CD. The CD

(photo CD) contains a collection of user-supplied images as well as an application program which enables the user to play a computer game that incorporates an image from the stored collection of images into the game [1:17-35]. This is taken to provide a software product having a computer readable medium storing a program which causes the computer to locate and select an image supplied by the user and incorporate the image into a game, and enable the user to play such a game. Tsubaki et al does not specify any particular actions to be carried out at the conclusion of the game. Small teaches a computer game where at the end of the game, Small teaches a computer game whereby a user of a personal computer or interactive TV is provided discount coupons and/or rebate information at the conclusion of the game; the user is then able to print coupons and rebate information [7:50-57]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a promotion/advertising/coupon component as taught by Small with the game of Tsubaki et al in order to provide sponsorship for the game, so as to add consumer value and/or to generate revenue or to offset costs for providing the game. The communication to the user at the conclusion of the game is taken to provide display of a message to the user.

Regarding claims 2, 10, 17, 22, 23, 25, 26, 31-33, Small teaches interaction between the user and remote computers via web sites over the Internet, including linking to web sites of participating manufacturers [col 5 lines 14-27]. It would have been obvious to one of ordinary skill at the time of the invention to have accomplished such promotional/advertising information delivery by way of the links mentioned by

Small at the conclusion of games, so that users can easily obtain such rebate information and can learn more about various products and browse the promoting manufacturer's web site(s). Providing links to manufacturer and product information pages at the conclusion of a game is taken to provide automated forwarding of a user to a remote computer site upon completion of the game; the user need not manually type in the URL/address of the destination site.

Regarding claims 13-15, 28-30, Tsubaki et al does not specify any particular game to be played. Small provides a matching game with images covering "hidden" tiles. The computer randomly selects product groups and checks to see if the user's selected hidden tiles match. If so, the hidden tiles are revealed. The computer uses images or a mosaic of images to provide the covering tile texture/surfaces. The game is Bingo, not concentration. However, Small teaches that other match games can be used instead [col 9 lines 12-15]. Official Notice is taken that the instantly described game of Concentration is a known game, where pairs of hidden cards/tiles are selected for matches to be revealed. It would have been obvious to one of ordinary skill at the time of the invention to have provided the promotional aspects of Small to the game of Tsubaki et al using any of Small's games or the known game of Concentration in order to provide a variety of experiences. Small provides a square section game/puzzle and it would have been obvious to one of ordinary skill at the time of the invention to have to have provided the known Concentration matrix as one which is square as a matter of design choice.

Claims 1, 11 and 16 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Tsubaki et al (US5815138) in view of Bernstein et al (US4314336). Bernstein teaches a computer game whereby the score is displayed to the user at the end of the game. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the score/results of the game of Tsubaki et al to the user after the game concludes in order to communicate to the player how well he did. Such a display is taken to be a "message".

Claims 3-6, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsubaki et al (US5815138) in view of Small (US5791991) and Walker et al (US6203427). The games of Small can result in winning prizes as well as receiving coupons [7:34-57]. Walker et al also teaches computer games. Each game/contest includes a gameID, customerID and winning information. The winning information is also encrypted [fig 11b, col 9 lines 1-25]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such game/contest identification means so that a winning player must verify the authenticity of the winning contest by any well known means such as by phone or computer, so as to eliminate fraudulent collection of prizes/coupons. It would have been obvious to one of ordinary skill at the time of the invention to have encrypted the contest and winning information to further secure against fraud.

Claims 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsubaki et al (US5815138) in view of Small (US5791991) and Barnett et al (US6336099). Small does not take steps to prevent a user from printing multiple copies of coupons. Barnett et al also teaches electronic coupon distribution, but takes steps to ensure coupons can only be printed once [col 5 lines 47-62]. It would have been obvious to one of ordinary skill at the time of the invention to have prevented users from printing awarded coupons more than once, so as to eliminate fraud and to encourage playing multiple games, thus being subjected to more sponsorship promotion.

Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsubaki et al (US5815138) in view of Small (US5791991) and Von Kohorn (US5916024). Tsubaki et al teaches that the game is provided on a CD medium. Von Kohorn teaches that computer games may be played on home computers whereby the game material (program) may be provided by an online (remote computer) source or by a CD containing the required game material [9:50 to 10:43]. Coupons can also be awarded to players based on their participation in the game. It would have been obvious to one of ordinary skill at the time of the invention to have provided the images and game program described by Tsubaki et al on the CD as described or by a remote computer system in a manner as described by Von Kohorn. This would enable the user to play the game from any connected computer without the need to tote the CD along.

Conclusion

The examiner will have a new telephone number (571-272-6716) effective April 14, 2005. The examiner's old telephone number (703-308-3402) will remain active until June 14, 2005. Similarly, the telephone number for the examiner's supervisor (Eric Stamber) will change from 703-305-8469 to 571-272-6724.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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